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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,816	06/19/2001	Robert D. Klein	MES-01-CON	4963

7590 08/07/2003  
DELTAGEN, INC.  
1003 Hamilton Avenue  
Menlo Park, CA 94025

EXAMINER
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LEFFERS JR, GERALD G

ART UNIT	PAPER NUMBER
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1636

13

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/885,816

Applicant(s)

KLEIN ET AL.

Examiner

Gerald G Leffers Jr.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 51-82 is/are pending in the application.
- 4a) Of the above claim(s) 51-60 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 61-69 and 72 is/are allowed.
- 6) ☒ Claim(s) 70, 71 and 73-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of a response, filed 5/30/03 as Paper No. 11, in which claims 61, 68-69 and 81 were amended. Claims 51-82 are pending in the instant application, with claims 51-60 withdrawn from consideration as being directed to a nonelected invention.

Any rejection of record not addressed in this action is hereby withdrawn. This action is not final due to new grounds of rejection made herein that were not necessitated by applicants' amendment of the claims in Paper No. 11.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 5/30/03 (Paper No. 12) disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of U.S. Application No. 10/087,523 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Specification***

The disclosure is objected to because of the following informalities: at page 12, line 13, the specification refers to U.S. Patent Application No. 07/847,298. Patent office records indicate that this is a miss assigned number and that no such application exists. It would be remedial to amend the specification to delete reference to this application number as it does not correlate to an actual application.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 70-71, 73-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 70 and 71 recite the limitation that the step of ligation independent cloning is done in one step (claim 70) or more than one step (claim 71). These limitations are unclear because, based upon the reaction components recited in (a)-(c) of the claims, it is unclear what is intended by the term "step". For example, it is unclear how generation of the product recited in step (d) by ligation independent cloning could be accomplished in a single biochemical step. For example, in the scenario presented by Figure 1, the skilled artisan would have to cleave out the insert comprising the positive selection marker prior to insertion of the targeting sequences on the flanks of the marker. In this case, would cleavage of the selection marker away from the vector of (c) constitute a single "step" or would the subsequent reinsertion of the marker into the vector comprising the flanking sequences constitute the a single "step"?

Claim 73 is vague and indefinite in that the metes and bounds of the phrase "oligonucleotide primers having 5' sequences lacking one type of base" are unclear. How much of the 5' end of the oligonucleotides must lack a single type of base in order to satisfy this claim limitation? Ten nucleotides? Twenty? It would be remedial to amend the claim language to clearly indicate how much of the 5' end of the oligonucleotides of step (b) must lack a particular base.

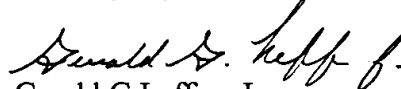
*Conclusion*

Claims 61-69 and 72 are allowed. Claims 70-71 and 73-82 are rejected. Claims 51-60 are withdrawn from consideration as being directed to a nonelected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr. whose telephone number is (703) 308-6232. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Gerald G Leffers Jr.  
Examiner  
Art Unit 1636

Ggl  
August 6, 2003